

## REMARKS

Reconsideration of the present application is respectfully requested in view of the above amendments to independent claims 1 and 10 and the following comments. Claims 1-18 remain pending in the application.

In the Office Action of December 3, 2001, original claims 1, 2, 4, 6-7, 10-11, 13, 15 and 16 were rejected under 35 U.S.C. § 102(e) as being directly anticipated by and unpatentable over U.S. Patent No. 5,688,595 to Yamagishi et al. Additionally, the remaining original claims, i.e. claims 3, 5, 8-9, 12, 14 and 17-18, were rejected under 35 U.S.C. § 103(a) as being obvious and unpatentable over Yamagishi et al.

However, Yamagishi et al. fails to disclose and/or remotely suggest the present invention. In this regard, Yamagishi et al. is directed to a multi-piece golf ball having a dual core and at least two distinct and critical cover layers, i.e. a soft outer cover layer and an even softer inner cover layer. This hard over soft cover arrangement differs distinctly from the embodiment of present invention set forth in claims which relates to a golf ball having single cover layer (independent claim 1) and/or a cover comprising a soft outer cover layer and a harder (as opposed to softer) inner cover layer (independent claim 10). Consequently, it is respectfully submitted that the present invention is clearly patentably distinct from the golf ball of Yamagishi et al.

More particularly, Yamagishi et al. is directed to a multi-piece solid golf ball having at least four (4) different layers in an attempt to approximate or improve the properties produced by threaded wound balls. Specifically, the golf ball of Yamagishi et al. consists of a core having a structure of at least two layers and a cover on the core consisting of outer and inner cover layers. Of particular importance, the outer cover layer has a Shore D hardness of 40-60 degrees and the inner cover layer has a Shore D hardness of up to 53 degrees and lower than that of the outer cover layer. Differently stated, the inner cover layer is always softer than the outer cover layer, i.e. hard over soft cover arrangement. Consequently, Yamagishi requires a multi-layer cover wherein a soft outer cover layer is formed around a softer inner cover layer.

This specific cover layer arrangement reportedly produces the specific "slip phenomenon" desired.

In this regard, Yamagishi states the following:

As defined above, the golf ball of the invention uses a two-layer cover wherein the outer cover layer has a hardness of 40 to 60 degrees on Shore D and the inner cover layer has a hardness of up to 53 degrees on Shore D and lower than that of the outer cover layer. Differently stated, inside a soft outer cover layer is formed a softer inner cover layer. This is one of the features of the invention. With the ball wherein the inner cover layer which is softer than the outer cover layer lies inside the outer cover layer which is soft in itself is subject to a driver shot providing a great value of  $F/N$  indicating that the perpendicular force  $F$  is greater than the parallel force  $N$ , a compressive force acts on the inner cover layer to a greater extent and a force acts in a shearing direction is smaller than the compressive force. Since soft layers are provided in the compression direction, the feel upon hitting is very soft and comparable to the feel of the wound balata golf ball. In addition, since the force in the shearing direction is small, the reaction force at the same site is small enough to restrain too much spinning. This ensures a low spin, flat and long-extending ball trajectory and carry that solid golf balls inherently possess.

On the other hand, when a club having a greater loft is used, the force in a shearing direction increases relative to the compressive force. Since the inner cover layer is formed as a softer layer, the amount of local deformation in a shearing direction increases in response to the shearing force. This restrains the slip phenomenon which is the drawback of solid golf balls. The resultant spin performance is approximate to that of the wound golf ball rather than the prior art solid golf balls designed in pursuit of spin performance. Thus the ball can respond an intentional shot.

Col. 2, lines 25-46 (Emphasis added).

Since Yamagishi requires a cover having a two layer structure consisting of a soft outer cover layer and an even softer inner cover layer to produce the "slip" and/or spin characteristics desired, the present invention is not disclosed or suggested by

Yamagishi et al. As clearly indicated throughout the present application, when two cover layers are utilized, the outer cover layer is softer (not harder) than the inner cover layer. For example, Applicants indicated the following:

It has been found that a hard inner cover layer provides for a substantial increase in resilience (i.e., enhanced distance) over known multi-layer covered balls. The softer outer cover layer provides for desirable "feel" and high spin rate while maintaining respectable resiliency. The soft outer layer allows the cover to deform more during impact and increases the area of contact between the club face and the cover, thereby imparting more spin on the ball. As a result, the soft cover provides the ball with a balata-like feel and playability characteristics with improved distance and durability. Consequently, the overall combination of the inner and outer cover layers and the unique dual core configuration results in a golf ball having enhanced resilience (improved travel distance) and durability (i.e., cut resistance, etc.) characteristics while maintaining and in many instances, improving the playability properties of the ball.

Page 9, lines 11-28 of the application.

As a result, Yamagishi et al. teaches a hard over soft cover arrangement which is the exact opposite of the cover arrangement of the present invention (i.e. soft over hard). Thus, Applicants respectfully request that the 35 U.S.C. §§ 102(e) and 103(a) rejections be withdrawn from consideration.

Additionally, the Examiner rejected claims 1-20 (presumably, 1-18) under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of Applicants U.S. Patent No. 6,216,895.

Although Applicants respectfully disagree with the Examiner, in an effort to hasten prosecution, Applicants herein submit a Terminal Disclaimer which disclaims the terminal portion of any patent granting from the instant application, as required under MPEP § 1490. Applicants respectfully submit that this overcomes the rejection.

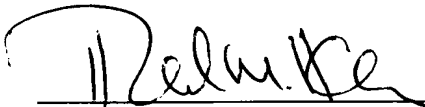
Since no other issue exists, Applicants submit that claims 1-18 are in condition for allowance. Attached hereto is a marked-up version of the changes made to the application by this Amendment. Should any issues remain with respect to the present application, the Examiner is encouraged to contact the undersigned attorney.

A marked-up version of the changes requested in this Amendment is attached hereto.

Respectfully submitted,

FAY, SHARPE, FAGAN,  
MINNICH & McKEE, LLP

March 4, 2005  
Date

  
Richard M. Klein  
Reg. No. 33,000  
1100 Superior Avenue  
Seventh Floor  
Cleveland, OH 44114-2518  
(216) 861-5582

Attachment  
N:\SLD\20106\2A\LAB0586A.WPD



COPY OF PAPERS  
ORIGINALLY FILED

Ser. No. 09/766,780  
Attorney Docket No.: P-5686U1-D1  
SLD 2 0106-2

**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

Please amend claims 1 and 10 as follows:

1. (Amended) A golf ball comprising:  
a dual core having a center component and a core layer disposed about said center component; and, a cover layer disposed about said dual core;  
wherein said center component comprises a thermoset material and said core layer comprises a thermoplastic material;  
wherein said cover layer includes [at least] a single outer cover layer having a Shore D hardness of from about 40 to 60.
10. (Amended) A multi-layer golf ball comprising:  
a dual core having a center component and a core layer disposed about said center component; and [at least one] a cover layer disposed about said dual core;  
wherein said center component comprises a thermoset material and said core layer comprises a thermoplastic material;  
wherein said cover layer includes at least [a single] an outer cover layer having a Shore D hardness of from about 40 to [50] 55 and an inner cover layer having a Shore D hardness of 60 or more.

RECEIVED  
MAR 20 2002  
TC 3100 MAIL ROOM